**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

SCS-540-522

Application Number

10/507,002

Filed

September 8, 2004

First Named Inventor

BRACEWELL

Art Unit

2123

Examiner

R. Guill

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

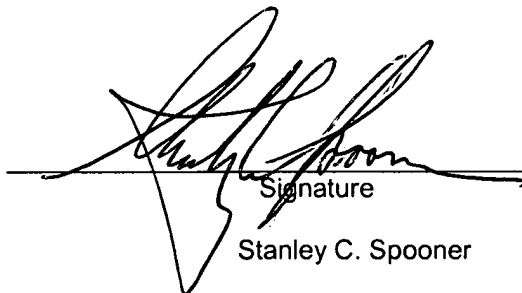
I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 27,393
(Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1.34 _____


Signature
Stanley C. Spooner

Typed or printed name

703-816-4028
Requester's telephone number

May 20, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

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**STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the 2nd Final Official Action mailed February 27, 2009 (Paper No. 20090223) (the fourth Office Action). The Examiner's Action, now replete with underlines and strike-throughs, still doesn't identify where the prior art references teach the claimed structures.

Error #1. The Examiner's contention that one of Conklin, Hirose and Regli teach the claimed limitation "said directed link is bi-directional to permit a user to traverse the link in either direction" is still incorrect

The Court of Appeals for the Federal Circuit has consistently held that "the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "It can satisfy this burden only by **showing some objective teaching in the prior art** or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." (emphasis added). *Id.* None of the references teach the claimed "directed link."

In the Final Rejection, the Examiner admits that Conklin does not teach the claimed "directed link is bi-directional to permit a user to traverse the link in either direction" (page 13, lines 4-5). The Examiner doesn't indicate that this structure is disclosed anywhere in Hirose or Regli. Instead, the best the Examiner can do is suggest that this claim limitation was somehow "well known at the time of the invention" in section "t" on page 13. The Examiner's continued reliance upon Official Notice is again traversed under MPEP §2144.03. The Examiner now cites

only three references (Kogan, Nguyen, & Weinreich, having dropped Hyman) which purportedly teach the claimed “directed link.”

With respect to the Kogan reference, the Examiner merely alleges that this teaches “bi-directional hyperlinks.” However, if the Kogan patent is reviewed, it clearly discloses bi-directional links that may have multiple endpoints, but it is unclear as to how such a system could be incorporated into a “design knowledge information capture tool” as recited in independent claim 1 or the method of claim 33.

The Kogan reference is alleged to teach “bi-directional hyperlinks” at column 4, lines 35-55 and between column 1, line 65 and column 2, line 2. The Examiner’s interpretation that Kogan has anything to do with Applicant’s claimed “directed link between selected nodes” is respectfully traversed. The reference, at column 4, merely discusses hyperlinks as being “bi-directional,” meaning it can be traversed in either direction. While such systems of course are well known, it is completely unknown to apply this aspect to a design knowledge information capture tool and there is nothing in Kogan which suggest how the general feature of the claimed “directed link” could be applied, especially to selected nodes representing items of design knowledge stored in different files.

The Examiner’s reference to the Nguyen patent purportedly teaches “bi-directional hyperlinks” although there is nothing in Nguyen which suggests the bi-directionality. It merely teaches links from a source to an anchor which may be considered a “hyperlink” but does not suggest that it is “bi-directional.” It is certainly not bi-directional in the sense of the present invention with respect to the linking of nodes relating to “items of design knowledge stored in different files.”

Weinreich, at least in the cited portion on page 22, discloses bi-directional linking, but specifically teaches away from its use in graphical maps (see the last three lines of the section entitled “Bi-directional links.” Thus, Weinreich would clearly teach away from the application of the claimed “directed link” between selected nodes where the nodes “represent items of design knowledge stored in different files.”

As noted above in the *In re Fine* decision above, the burden is on the Examiner to establish where each claimed structure is disclosed in a combination of prior art references and, thus far, the Examiner has failed to meet this burden. Absent a disclosure of the claimed “directed link between selected nodes” and wherein the selected nodes represent “items of design knowledge stored in different files” somewhere in the patchwork quilt of prior art references, the rejection of the independent claims and claims dependent thereon clearly fails for lack of evidence amounting a *prima facie* case of obviousness.

Error #2. The Examiner fails to provide any rationale for combining bits and pieces of the three cited references and then combining them in the manner of Applicant’s independent claims

On pages 8-9, the Examiner alleges general benefits of each of the prior art references as a motivation for combining portions of references, but there is no recognition that they can be combined in the manner of the pending claims or that they would provide the benefit disclosed in the pending application. In its recent decision, the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), held that “[t]o facilitate review [of the reasons for combining prior art], this analysis should be made explicit.” *Id.* at 1396. The Supreme Court in its *KSR* decision went on to say that it followed the Court of Appeals for the Federal Circuit’s advice that “rejections on obviousness grounds cannot be sustained by mere conclusory

statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added, the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

In section 5(r)(ii) on page 7, the recitation of benefits of the Hirose reference “cost effective, useful and inexpensive design process recorder” is alleged to be the “motivation” why one would combine Hirose with Conklin. However, these benefits have nothing to do with the elements being chosen from Hirose and combined with specific elements of Conklin. There is no indication as to why one of ordinary skill in the art would ignore the other teachings in the Hirose and Conklin references. As a result, the Examiner’s statement in section r(ii) is merely a conclusory statement reciting generic benefits, i.e., “cost effective,” “useful” and “inexpensive.”

In section 5(t)(ii) on page 8, the Examiner again makes a broad sweeping conclusory statement that “to use the art of Regli with the art of Conklin” which presumably includes anything disclosed in Regli and anything disclosed in Conklin, would “provide a great aid to designers” and therefore this is the purported motivation for combining elements. Again, the Examiner simply fails to provide any reason to pick and choose the “directed link” (which he does not even allege is disclosed in Regli) with the other elements of the Conklin reference and the Hirose reference in the manner claimed.

It is Applicant’s view that the Examiner has simply utilized hindsight reasoning in picking and choosing elements from Conklin, Hirose, Regli and the purported Official Notice references and then alleging that it would be obvious to combine them in a manner which is taught only by Applicant’s independent claims to provide a benefit which is only taught in the

present application. This is not the standard of obviousness and the Examiner has failed to meet the test set out in KSR.

Error #3. The Examiner does not cite any portion of the Kogan, Nguyen and Weinreich references, which he alleges contains “bi-directional hyperlinks,” as teaching the claimed “directed link” as defined in the claims

It is the structure recited in Applicant’s claims which must be disclosed in at least one prior art reference in a combination rejection under §103. The Examiner has not indicated how or where Kogan, Nguyen or Weinreich teach Applicant’s claimed “directed link” instead of the Examiner’s hyperlink. If the Examiner cannot point to where or how a prior art reference teaches a “directed link between selected nodes” which is “bi-directional to permit a user to traverse the link in either direction” and “wherein said selected nodes represent items of design knowledge stored in different files” there is simply no evidentiary disclosure of that claimed element.

SUMMARY

In the Final Rejection the Examiner continues to refuse to identify where any reference teaches the claimed “directional link.” Instead, the Examiner alleges only that the prior art references “appear” to teach claimed features, but **appears to teach** is not the standard of obviousness. Additionally, the Examiner’s inability to provide any explicit “analysis” as required by the KSR court is fatal to the purported *prima facie* case of obviousness.

As a result of the above, there is simply no support for the rejection of Applicants' independent claim 1 and 33 or claims dependent thereon under 35 USC §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.